REMARKS

Claims 17-24, 26-30, 32, 44-46, 48-49, 54, 60-62, 68-70, and 72-76 are pending in the application. Claims 17-24, 26-30, 32, 44-46, 48-49, 54, 60-62, 68-70, and 72-76 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 17-24, 26-30, 32, 44-46, 48-49, 54, 60-62, 68-70, and 72-76 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 77-78 are added. Claims 17-24, 26-30, 32, 44-46, 48-49, 54, 60-62, 68-70 and 72-78 remain in the case for consideration.

REJECTIONS UNDER 35 U.S.C. § 112

In rejecting claim 17, the Examiner argues that:

> [L]ines 5-7 of claim 17 recites "determining a relationship between the first object and the second object; using the contract object to represent the relationship between the first object and the second object" which supports at least the first and second objects participate in the usage of the claimed contract object. Therefore, the last two lines seem to contradict the limitations recited in lines 5-7.

(*see* Office Action dated February 18, 2009, pages 2-3). The Applicant respectfully disagrees.

First, it is entirely possible for there to be a relationship between the first object and the second object, and yet the contract object be created "without participation by a user, the first object, or the second object". The fact that a relationship might exist between the first object and the second object does not mean that the objects participate in the creation of the contract object. For example, the objects can be inanimate objects. The Examiner cites the example described in the specification on page 6, lines 9-10, involving file 115 and collection 205. Inanimate objects, by definition, cannot participate in anything, as participation is an action, and requires active involvement. Inanimate objects can, of course, be used, and can be part of a relationship. But the manipulation of inanimate objects by outside forces is not the same thing as "participation" by the objects. For example, the players in a football game participate; the football does not.

As a second example, consider two people who are brother and sister, and therefore have a "sibling" relationship. This sibling relationship exists simply as a result of the identities of their parents: if the two people have the same biological mother and father, they are siblings.

The people themselves are not involved in the creation of this relationship. This shows that, even with animate objects like people, a relationship can be created without the "participation" of the objects.

New claims 77-78 emphasize the fact that the relationship between the objects can be established without the participation of the objects. New claims 77-78 further distinguish the claimed invention over Gower (as cited in the Office Action dated September 18, 2008), in that the database contract of Gower requires the active participation of the principals.

Second, even if the first object and second object "participate" in the relationship (or its creation), that fact alone does not mean that the first object and the second object "participate" in the creation of the contract object that represents that relationship. For example, in the above football example, even if the football could be said to "participate" in the game, the football does not "participate" in establishing the rules that define the game. In the same way, objects might be related, but the objects do not automatically "participate" in the creation of the contract object that represents that relationship.

Even if the two objects in the relationship are animate objects, it does not automatically follow that the two objects must participate in creating the contract object. Continuing the earlier example of two siblings, the fact that the two people are siblings does not mean that they necessarily participate in creating the contract object that represents that relationship: a third party might create the contract object without either of the siblings even being aware of the fact that the contract object has been created. For example, if a person visits a web site that allows the creation of a genealogical tree, the genealogical tree can be created (and therefore represent relationships among people) without the people in the tree being aware of the genealogical tree's creation.

As a further example, in Gower, cited in rejecting claim 17 in the Office Action dated September 18, 2008, the database contract is a legal contract between parties in the real world. A legal contract in the real world cannot be imposed on parties: they must actively agree to the legal contract. Gower even states that "[a] database contract is formed when two or more principals agree on the terms and conditions of the contract" (*see* Gower, Abstract). For the principals to "agree on the terms and conditions of the contract" requires the principals' active involvement: i.e., the principals' participation in the creation of the database contract. Gower's

database contract therefore cannot be created without the principals participating in the creation of the database contract.

But, unlike Gower, the creation of the contract object in the claims does not require the participation of the objects. A relationship can be imposed on objects by forces external to the objects: the objects do not have to "participate" in the creation of the relationship. Similarly, the contract object that represents the relationship can be created without the "participation" of the objects having the relationship. But this is precisely what is recited in claims 17 and 44, and therefore the claims are enabled by the specification and are not indefinite.

The Examiner also argues:

> Further, the specification further supports that the first object and the second object participate in the usage of the contract. For example, page 6, lines 9-10 recite file 115 (first object) and collection 205 (second object) have a list of associated contracts "allows both file 115 and collection 205 to locate contract 215, which establishes the relationship between file 115 and collection 205". Therefore, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

(*see* Office Action dated February 18, 2009, pages 3). The Applicant respectfully disagrees.

As argued above, it is possible for a relationship to be imposed between objects, without the objects being involved in the creation of that relationship. For example, if a user decides to move a file from one collection to another, a person of ordinary skill in the art would understand that this event occurs without either of the collections or the file even being aware of the change, as the file and the collections are all inanimate objects. This specific situation is illustrated in FIG. 5B of the specification, and in the accompanying description on page 7, line 27 through page 8, line 2. Therefore, the specification is consistent with the claims, in that the creation and maintenance of the contract object can occur without the participation of the objects, and the claims are enabled by the specification and are neither vague nor indefinite.

With reference to the "associated lists" mentioned by the Examiner, the Applicant does not believe the specification requires that these associated lists must be created and/or maintained by the objects in question. Put another way, the specification supports the concept that these associated lists can be created/maintained for the objects without having to be created/maintained by the object. But even if the creation/maintenance of the associated lists is the responsibility of the object, the object can create/maintain the associated lists responsive to the modification of contract object, without participation in the creation or modification of the

contract object. In other words, an object can be notified about a change in the contract object, and can update its associated lists as a result. Therefore, the specification enables one of ordinary skill in the art to make and/or use the invention and the claims are neither vague nor indefinite, and therefore the claims are patentable under 35 U.S.C. § 112, ¶¶ 1 and 2. The Applicant respectfully requests the Examiner to withdraw the rejections.

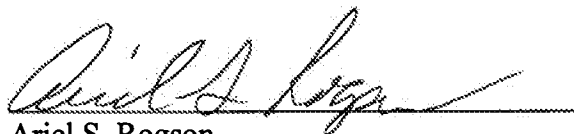<p style="text-align:center">REJECTIONS OVER THE PRIOR ART</p>

Even though the claim feature "wherein the contract object is created and used without participation by a user, the first object, or the second object" was added in response to the Office Action dated September 18, 2008, the Applicant respectfully submits that the claims require no "speculation and conjecture" (*see* Office Action dated February 18, 2009, page 4) to be understood. Notwithstanding the Examiner's citation to *In re Steele* and *In re Wilson*, M.P.E.P. § 2143.03 requires that all claim limitations be considered, even limitations that are considered indefinite or that are considered to lack support in the original specification. The Applicant also notes that in the Office Actions dated December 5, 2006 and March 26, 2007, and the Advisory Action dated February 22, 2007, the Examiner had no problem rejecting the claims over prior art, even though the Examiner thought some of the claims failed to comply with the written description requirement or were indefinite. If the Examiner could have examined the claims over the prior art in the earlier Office Actions, the Examiner could have examined the currently pending claims, especially given the Applicant's clear intent, as represented by the amendment in response to the Office Action dated September 18, 2008.

In addition, *In re Wilson* states that "[i]f no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious — the claim becomes indefinite". All this means is that, if a term in the claim cannot be assigned a reasonably definite meaning, the appropriate rejection is under 35 U.S.C. § 112, ¶ 2, not under 35 U.S.C. § 103(a). But the claim must still be examined relative to the prior art: indefiniteness is not an excuse for not examining claims under 35 U.S.C. §§ 102 and 103 ("All words in a claim must be considered in judging the patentability of that claim against the prior art"). In other words, Wilson stands for the proposition that a claim might be indefinite but still non-obvious; Wilson does not stand for the proposition that an indefinite claim limitation justifies not attempting to examine the claims relative to the prior art.

For the foregoing reasons, reconsideration and allowance of claims 17-24, 26-30, 32, 44-46, 48-49, 54, 60-62, 68-70, and 72-78 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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